

**OLIVA****Serial No. 09/497,552**

first means in a surrounding portion of the optical element and around an outer edge of the focusing lens, adapted to separate a central portion of the laser beam from a surrounding portion of the laser beam;

wherein the entire central portion of the laser beam collected by the lens is focused.

### **REMARKS**

Reexamination and favorable consideration of the captioned application is respectfully requested.

#### **A. SUMMARY OF THIS AMENDMENT**

By the current amendment, Applicant basically:

1. Amend independent claim 32 and respectfully traverse the prior art rejections (prior art rejections have been formulated only with respect to independent claim 32 and claims 33 - 35 dependent thereon).
2. Respectfully traverse the provisional obviousness-type double patenting rejection.

#### **B. PRIOR ART ISSUES AND PATENTABILITY OF THE CLAIMS**

Once again, the only claims which have sustained a prior art rejection are claims 32 - 35. Claims 32 - 35 stand finally rejected as anticipated under 35 USC §102(b) by US Patent 5,886,332 to Plesko. This prior art rejection is respectfully traversed for at least the following reasons.

Independent claim 32 has been amended to specify that the focusing lens is in a central portion of the optical element, and that the first means is in a surrounding portion of the optical element and around an outer edge of the focusing lens. These amendments

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constitute neither new matter nor new issues. It is clear in the previous prosecution, e.g., from independent claim 29, for example, that the first means is formed in the optical element, and in particular in a surrounding portion of the optical element (surrounding the focusing lens). These amendments are matters of editorial clarity and are offered to moot the rejection under 35 USC §112, first paragraph<sup>1</sup>.

Support for the amendatory language occurs in the original disclosure, e.g., with reference to a second alternative embodiment described, e.g., in the text commencing with the last paragraph on page 17 (see also Figs. 5 and 6). Please note particularly in this regard reference to the "surrounding portion 121".

Plesko discloses means for scattering or blocking a portion of the light beam which are directly applied on the focusing lens, so that only a portion of the laser beam collected by the focusing lens is focused. Differently, amended claim 32 recites that the first means for separating a central portion of the laser beam from a surrounding portion of the laser beam is disposed on a surrounding portion of the optical element. Thus, Applicant's first means forms part of the optical element, but does not form a part of the focusing lens. Rather, Applicant's focusing lens is disposed in a central portion of the single optical element, so that the entire central portion of the laser beam collected by the focusing lens (e.g., all the portion of the laser beam incident on the focusing lens) is focused. In other words, the first means recited in claim 32 are neither part, or directly applied on, the focusing lens thus allowing the entire central portion of the laser beam collected by the focusing lens to be focused, differently by Plesko wherein the means for

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<sup>1</sup> Applicant considers the "exteriorly surrounding" language previously resident in independent claim 32 to be fully supported in the specification and drawings for reasons already of record. But as an accommodation to the Examiner, particularly in view of the late stage of proceedings, Applicant has rescinded such language. The "around an outer edge of the focusing lens" phraseology which still resides in independent claim 32 was previously not objectionable, and therefore believed not objectionable.

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scattering or blocking a portion light beam are either applied or formed on the periphery of the focusing lens thus allowing only a central portion of the laser beam collected by the focusing lens to be focused.

Therefore, the Applicant's invention as claimed in amended claim 32 allows propagation of the entire central portion of the laser beam collected by the focusing lens. This object cannot be achieved by Plesko, wherein a portion of the focusing lens is covered or machined to block or scatter the outer portion of the laser beam collected by the focusing lens. In view of the above, claim 32 should be considered novel and non obvious over Plesko.

A further advantage provided by the Applicant's invention with respect to Plesko is that while Plesko's focusing lens must be machined or treated, the Applicant's lens does not require any machining or treatment and its manufacturing is therefore more simple than that of Plesko. For the same reason, the Applicant's lens can be even more miniaturized than that of Plesko.

As such, independent claim 32 is directed to an optical device including means for selecting a central portion of the laser beam, such means being associated with an intact focusing lens (that is, a focusing lens which is not machined (e.g., by grinding or etching), nor covered by any paint or coating or mask). Since no portion of the lens is covered or machined, this focusing lens is advantageously capable of focusing the entire laser beam which is collected thereby.

By contrast, US Patent 5,886,332 to Plesko discloses a focusing device including a focusing lens having a peripheral area directly applied to the other surface of the lens (by applying a frosted tape, paint, or the like) or formed as an integral part of the surface of the lens. Plesko also discloses that the outer surface of the lens may be made opaque in order to block light passing therefrom (see col. 7, lines 3 to 34, col. 8, lines 13 - 48 and

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54 - 62, Fig. 9, Figs. 11A - 11E). In any event, US Patent 5,886,332 to Plesko discloses means for scattering or blocking a portion of the light beam which are directly applied or provided on the peripheral portion of the lens so that only a central portion of the light beam collected by the focusing lens is focused.

In view of the foregoing and other considerations, the prior art rejections against claims 32 - 35 should be withdrawn.

**C. PROVISIONAL OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION**

Claims 1, 2, 4, 5, 11 - 15, 29, 32 - 36 are again provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over claims 1 - 36 of US Patent application Serial Number 09/773,384. The provisional obviousness-type double patenting rejection is inappropriate, particularly since (as explained in section B hereof) independent claim 32 and claims 33 - 35 are allowable. The application thus stands without any rejection other than the obviousness-type double patenting rejection, in which case the last two paragraphs of MPEP §804(I)(B) are operative [see copy attached]. The obviousness-type double patenting rejection thus should be withdrawn.

Without conceding any issue of obviousness either now or in the future, Applicant does not waive the right or possibility of filing in the future a Terminal Disclaimer in the captioned application in order to expedite prosecution of the captioned application.

**D. MISCELLANEOUS**

In view of the foregoing and other considerations, a formal indication of allowance is earnestly solicited.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page(s) is captioned "Version With Markings To Show Changes Made."

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The Commissioner is authorized to charge the undersigned's deposit account #14-1140 in whatever amount is necessary for entry of these papers and the continued pendency of the captioned application.

Should the Examiner feel that an interview with the undersigned would facilitate allowance of this application, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

May 12, 2003

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I hereby certify that this Amendment After Final, Amendment Transmittal and Correspondence Address Indication Form is being facsimile transmitted for official filing to the Patent and Trademark Office on May 12, 2003, and specifically to 703-308-7724.



H. Warren Burnam, Jr.

Reg. 29, 366

May 12, 2003

date

No. of pages transmitted: 11 <sup>11/23</sup> ~~10~~ pages

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS**

Please amend claim 32 as follows:

32. {TWICE AMENDED} Optical device for focusing a laser beam, said device comprising a single optical element upon which the laser beam is directed, said single optical element comprising:

a focusing lens in a central portion of the optical element; and

first means in a surrounding portion of the optical element and around ~~exteriorly surrounding~~ an outer edge of the focusing lens, adapted to separate a central portion of the laser beam from a surrounding portion of the laser beam;

wherein the entire central portion of the laser beam collected by the lens is focused.

## RESTRICTION IN APPLICATION FILED UNDER 35 U.S.C. 111; DOUBLE PATENTING

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**I. INSTANCES WHERE DOUBLE PATENTING ISSUE CAN BE RAISED**

A double patenting issue may arise between two or more pending applications, between one or more pending applications and a patent, or between one or more pending applications and a published application. A double patenting issue may likewise arise in a reexamination proceeding between the patent claims being reexamined and the claims of one or more applications and/or patents. Double patenting does not relate to international applications which have not yet entered the national stage in the United States.

**A. Between Issued Patent and One or More Applications**

Double patenting may exist between an issued patent and an application filed by the same inventive entity, or by an inventive entity having a common inventor with the patent, and/or by the owner of the patent. Since the inventor/patent owner has already secured the issuance of a first patent, the examiner must determine whether the grant of a second patent would give rise to an unjustified extension of the rights granted in the first patent.

**B. Between Copending Applications—Provisional Rejections**

Occasionally, the examiner becomes aware of two copending applications filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee that would raise an issue of double patenting if one of the applications became a patent. Where this issue can be addressed without violating the confidential status of applications (35 U.S.C. 122), the courts have sanctioned the practice of making applicant aware of the potential double patenting problem if one of the applications became a patent by permitting the examiner to make a "provisional" rejection on the ground of double patenting. *In re Mon*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976); *In re Wetterau*, 356 F.2d 556, 148 USPQ 499 (CCPA 1966). The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.

The "provisional" double patenting rejection should continue to be made by the examiner in each

application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

If the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.

**C. Between One or More Applications and a Published Application - Provisional Rejections**

Double patenting may exist between a published patent application and an application filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee. Since the published application has not yet issued as a patent, the examiner is permitted to make a "provisional" rejection on the ground of double patenting. See the discussion regarding "provisional" double patenting rejection in subsection B. above.

**D. Reexamination Proceedings**

A double patenting issue may raise a substantial new question of patentability of a claim of a patent, and thus be addressed in a reexamination proceeding. *In re Lonardo*, 119 F.3d 960, 966, 43 USPQ2d 1262, 1266 (Fed. Cir. 1997) (In giving the Commissioner authority under 35 U.S.C. 303(a) in determining the presence of a substantial new question of patentability, "Congress intended that the phrases 'patents and publications' and 'other patents or publications' in section 303(a) not be limited to *prior art* patents or printed publications." (emphasis added)). Accordingly, if the issue of double patenting was not